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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,468	11/14/2001	Kevin I. Bertness	C382.12-0097	2983

7590 06/01/2005

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EXAMINER


HARVEY, JAMES R

ART UNIT	PAPER NUMBER
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2833

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/993,468	Applicant(s) BERTNESS, KEVIN I. 	
	Examiner James R. Harvey	Art Unit 2833	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on interview dated 6-8-04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 9-13 is/are pending in the application.
 4a) Of the above claim(s) 5-8 and 14-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 9-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11-14-01.
- 4) ☒ Interview Summary (PTO-413) Paper No(s) 06142004.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Previous Indication of Allowability Withdrawn

The indicated allowability of claim 1 and those claims dependent thereon is withdrawn in view of the reconsideration of applicant's argument that the word "surrounds" has the same patentable weight as "completely surrounds".

Applicant's argument pointed out that the narrow definition of "surrounds" defines the limitation of the claim to mean:

a loop that "extends on all sides of" the battery post.

This narrow definition supports applicant's position that the limitation "surrounds" would be patentable over Kimber and Trafton.

However, another broader definition of "surrounds" defines the limitation of the claim to mean:

a loop that "constitutes part of the environment of" the battery post.

This broader definition supports the office's position that the limitation "surrounds" is not patentable over Kimber or Trafton.

Information Disclosure Statement

- After the notice of allowance, applicant notified the examiner that 1 of the 8 information disclosure statements was not reviewed by the examiner. The examiner requested the relevant documents be provided. Applicant then provide a 13 page IDS.

- The 13 page Information Disclosure statement(s) and related documents that were filed on 11-14-01 have been considered.
- Please review the 8 information disclosure statements to insure that all the information has been disclosed to the examiner.

Claim Rejections - 35 USC § 102

- The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- Claim(s) 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kimber (5108320).

-- In reference to claim 1, Kimber shows (cover sheet)

a first contact 20 having a surface which at least partially conforms to and can be adapted to engage and electrically connect to a surface of the post 12;

a second contact 19 having a surface which at least partially conforms to and is adapted to engage and electrically connect to the surface of the post; and

an electrical insulator 31 (cover sheet) and (figure 6) between the first contact 20 and the second contact 19 to align the surface of the first contact 20 and the surface of the second contact 19 against the surface of the post and thereby form a Kelvin connection to the post, wherein the first contact, the second contact and the insulator form a loop hat surrounds the battery post.

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-- In reference to claim 1, lines 1 and lines 7-9, concerning the claim language "thereby form a Kelvin connection to the post", as was discussed in the previous rejection, the meaning of Kelvin connection has been defined by the applicant on page 2, lines 1-4 of the originally filed application. The Kelvin connection is simply defined as a technique and the only structure it requires is that structure necessary to create an electrical contact.

In particular reference to the claim language surround, it is noted that neither the reference or applicant's drawing (figure 1) show the limitation "completely surrounding".

-- In reference to claim 9, Kimber shows a first connection bar adjacent conductor 21 (cover sheet) integral to the first electrical contact 20 and a second connection bar 22 integral to the second electrical contact 19.

- Claim(s) 1, 3, 4, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Trafton (5865638).

-- In reference to claim 1, Trafton shows (cover sheet)

a first contact 30 having a surface which at least partially conforms to and is adapted to engage and electrically connect to a surface of the post 40 (figure 3) and (column 4, lines 62-67);

a second contact 14 having a surface which at least partially conforms to and is adapted to engage and electrically connect to the surface of the post 40; and

an electrical insulator 34 between the first contact 30 and the second contact 14 to align the surface of the first contact 30 and the surface of the second contact 14 against the surface of the post and thereby form a Kelvin connection to the post, wherein the first contact, the second contact and the insulator form a loop hat surrounds the battery post.

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-- In reference to claim 3, Trafton shows the first contact 30 and the second contact 14 oppose each other at the insulator 34.

-- In reference to claim 4, Trafton shows the first contact 30 has an insulator support portion 36 which is embedded within the electrical insulator (figure 4) and (column 4, lines 45-62); and a post grasping portion (figure 3) on which the surface of the first contact 30 resides.

-- In reference to claim 10, Trafton shows the first electrical contact and the second electrical contact are formed from electrically conductive sheet metal.

Claim Rejections - 35 USC § 103

- The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- Claim(s) 11-13 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Trafton.

-- In reference to claim 11, Trafton Shows substantially the invention as claimed. However, Trafton does not show the first electrical contact and the second electrical contact are copper pieces with solder plating.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the material as copper with solder plating, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416

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(CCPA 1960). One skilled in the art would be motivated to choose a material of copper and solder plating because it would be more ecstasically pleasing and make it easier to solder the wire conductor to the metal.

It is noted that Kimber shows the contacts are nickel plated copper and that the above rejection was used with a different reference in the previous rejection.

-- In reference to claim 12, Trafton shows substantially the invention as claimed. However, Trafton does not show the insulator comprises plastic.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the material as plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416 (CCPA 1960). One skilled in the art would be motivated to choose the insulator as plastic because it easily conforms to most desired shapes.

It is noted that the above rejection was used with the previous reference in the previous rejection.

-- In reference to claim 13, Trafton shows substantially the invention as claimed. However, Trafton does not show the insulator comprises a composite material.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the material a composite material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416 (CCPA 1960). One skilled in the art would be motivated to use a composite material because composite

materials are easier to keep clean than other insulators and would be more ecstatically pleasing after years of service.

It is noted that the above rejection was used with the previous reference in the previous rejection.

Response to Arguments Submitted After the Final Office Action

-- In response to applicant's argument (page 2, line 5) concerning that the word "surrounds" has the same patentable weight as "completely surrounds" based upon applicant's definition from the dictionary, the examiner disagrees.

Applicant's argument pointed out that the narrow definition of "surrounds" defines the limitation of the claim to mean:

a loop that "extends on all sides of" the battery post.

This narrow definition supports applicant's position that the limitation "surrounds" would be patentable over Kimber.

However, another broader definition of "surrounds" defines the limitation of the claim to mean:

a loop that "constitutes part of the environment of" the battery post (see attached

definition from Merriam-Webster's Collegiate Dictionary (Tenth Edition)) .

This broader definition supports the office's position that the limitation "surrounds" is not patentable over Kimber or Trafton.

Further, if applicant's argument is that the claimed contacts "extend on all sides simultaneously", the post is seen as a cylinder with a top side that is flat and a bottom side that is

within the battery and an outer circumference. Applicant's contacts and insulator do not extend over the top side or the bottom side and do not meet this definition "extends on all sides".

-- In response to applicant's argument (page 2, line 14) concerning applicant's opinion that the insulator of Kimber does not meet the limitation "to align the surface of the first contact and the ... second contact against the surface of the post", the examiner disagrees. The insulator of Kimber is used "to align" the contacts within a predetermined distance with respect to each other and in an orthogonal orientation with the post at that predetermined distance.

-- In response to applicant's argument (page 2, line 27) concerning that Trafton is not capable of "engaging/surrounding" a battery post, this recitation has not been positively recited in the claims and is therefore seen to not be convincing.

-- In response to applicant's argument (page 2, line 32) concerning that the previous rejection indicated that element 40 of Trafton is not a battery post, the examiner disagrees. The claim language concerning the battery post is "adapted to" (claim 1, lines 4 and 7). The recitation is not claiming the battery post, the claim only requires the structure be adapted to be used for the intended purpose of engaging and electrically connecting to a post and Trafton is capable of performing the same intended use.

It has been held a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Trafton shows the same structure as a post in the cylindrical element 40 (figure 3) and the bottom surface of the first contact 12 of Trafton and the top surface of the second contact 14 are "adapted to" engage the post 40.

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-- In response to applicant's argument (page 3, line 2) concerning applicant's opinion that Trafton does not show an insulator used "to align" the surface of the first and second contacts. Figure 4 of Trafton shows the insulator 34 performing the same aligning function and makes the recitation unpatentable.

Summary of Interview Concerning Allowable Claim Language

The office suggested two options to get the application into condition for allowance. The first option was to amend the claim language by adding "substantially flat" to the limitation of each of the first and second contacts. The second option was to amend the claim language to claim the resilient fingers of the first and second contacts in a manner such as "the first and second contact each having at least one resilient finger extending inwardly toward the post". Applicant's representative did not agree to either option.

Conclusion

- Effective May 1, 2003, the United States Patent and Trademark Office has a new Commissioner for Patents address. Correspondence in patent related matters must now be addressed to:

**Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450**

For additional information regarding the new address, see Correspondence with the United States Patent and Trademark Office, 68 Fed. Reg. 14332 (March 25, 2003).

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- Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Harvey whose telephone number is 571-272-2007. The examiner can normally be reached on 8:00 A.M. To 5:00 P.M.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on 571-272-2800 (ext. 33).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

- Effective **October 1, 2003**, all patent application related correspondence transmitted by facsimile must be directed to the central facsimile number, **(703) 872-9306**, with a few exceptions *See Fax Automation in Technology Center 1700, 1237 Off. Gaz. Pat. Office 140* (August 29, 2000). Replies to Office actions including after-final amendments that are transmitted by facsimile must be directed to the central facsimile number

James R. Harvey, Examiner

jrh
July 2, 2004


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